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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,046	06/24/2003	James H. Wright	WRIGP001US	1045
27949 7590 05/31/2007 LAW OFFICE OF JAY R. YABLON 910 NORTHUMBERLAND DRIVE SCHENECTADY, NY 12309-2814			EXAMINER JOYNER, KEVIN	
			ART UNIT 1744	PAPER NUMBER
			MAIL DATE 05/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/604,046	Applicant(s) WRIGHT, JAMES H.	
	Examiner Kevin C. Joyner	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 17-20, 22 and 30-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21 and 23-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-29 and Species E, claim 21 in the reply filed on May 1, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 17-20, 22, and 30-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 1, 2007.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7, 8, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Thinnes (U.S. Publication No. 2003/0189055)

Thinnes discloses an anti-splash, anti-spill fluid holding apparatus, comprising:

An inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter;

An outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter (paragraph 53, lines 14 and 15);

An inward angle comprising a less than 90 degree angle tangential to any point along said inner side surface from said inner mid section diameter to said inner upper section diameter;

An open top circumscribed by said inner upper section diameter; and

A base circumscribed by said outer lower section diameter as shown in Figure 2A and disclosed in paragraph 15.

Regarding claim 7, Thinner continues to disclose that the apparatus further comprises omitting any anti-splash element comprising an inward angle greater than or equal to 90 degrees tangentially at any point between said inner mid section diameter and said inner upper section diameter. More specifically as shown in Figure 2, since the apparatus is shaped where the mid section diameter is greater than the upper section diameter, which provides an inward slope, then the apparatus will omit an anti-splashing element comprising an inward angle greater than or equal to 90 degrees. Concerning claim 8, the reference also discloses that the inward angle continuously increases at all points along the inner side surface from the inner mid section diameter to the inner upper section diameter as shown in Figure 2a as well. Regarding claim 11,

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Thinnes discloses that said inner side surface, said outer side surface, said points along said inner side surface forming said inward angle, and said base comprise a single unitary article of fabrication (paragraph 53). More specifically, as shown in Figure 2a, the apparatus is clearly one unitary article of fabrication. As disclosed in paragraph 53, the apparatus is made from glass or a composite material, wherein it is known that the apparatus will be made from a single unitary article of fabrication.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7, 11, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Slonim (U.S. Patent No. 6,116,426).

Slonim discloses an anti-splash, anti-spill fluid holding apparatus, comprising:

An inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof, which is smaller than said inner mid section diameter;

An outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter;

An inward angle comprising a less than 90 degree angle tangential to any point along said inner side surface from said inner mid section diameter to said inner upper section diameter;

An open top circumscribed by said inner upper section diameter; and

A base circumscribed by said outer lower section diameter as shown in Figure 1 and referenced as numeral 14 (column 3, lines 53-66). More specifically, the apparatus is a conventional apparatus utilized to hold an antiseptic solution, which are generally hollow on the interior. Thus, the interior shape of the apparatus will coincide with the exterior shape of the apparatus which would provide an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter. With reference to the open top, it is known that the apparatus will have an open top in order to remove or add fluid to the apparatus, in which the inner upper section diameter will be circumscribed. Since the apparatus presents the dimensions as described above, then it is an anti-spill, anti-splash apparatus.

Regarding claim 7, Slonim continues to disclose that the apparatus further comprises omitting any anti-splash element comprising an inward angle greater than or equal to 90 degrees tangentially at any point between said inner mid section diameter and said inner upper section diameter. More specifically as shown in Figure 1, since the apparatus is shaped where the mid section diameter is greater than the upper section diameter, which provides an inward slope, then the apparatus will omit an anti-splashing element comprising an inward angle greater than or equal to 90 degrees.

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Concerning claim 11, Slonim discloses that said inner side surface, said outer side surface, said points along said inner side surface forming said inward angle, and said base comprise a single unitary article of fabrication as shown in Figure 1.

Regarding claims 25 and 26, the apparatus further comprises a sterile state suitable for utilization in surgical procedures in combination with a surgical kit comprising:

Said fluid holding apparatus (14); and

At least one item of surgical equipment other than said fluid holding apparatus (numerals 4, 6, 8, 10, 12, 13, 16, 18, 20 22) as disclosed in column 3, lines 53-66.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6, 9, 10, 12-16, 21, 23-24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thinner (U.S. Publication No. 2003/0189055).

Claims 2-6 further requires that the inward angle comprising a no more than approximately 15 degree angle tangential to any point from said inner mid section diameter to said inner upper section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the angle tangential to any point

from said inner mid section diameter to said inner upper section diameter to no more than 15 degrees in order to maximize the efficiency of the anti-splash, anti-spill in the apparatus. Only the expected results would be attained.

Claims 9 and 10 further requires that the inner section ratio be approximately 1 to 0.875 between said inner mid section diameter and said inner upper section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the ratio between the inner mid section diameter and the inner upper section diameter in order to maximize the efficiency of the anti-spill, anti-splash apparatus. Only the expected results would be attained.

Claims 12 and 13 further requires that the fluid holding volume is approximately 37.5 cubic centimeters. It would have been well within the purview of one of ordinary skill in the art to optimize the fluid holding volume in order to maximize the appropriate amount of fluid needed for the usage of the apparatus. Only the expected results would be attained.

Claims 14-16 further requires that the inner side surface height be approximately 3 centimeters and the inner mid section diameter by approximately 4 centimeters. It would have been well within the purview of one of ordinary skill in the art to optimize inner surface height and inner mid section diameter in order to maximize the efficiency of the anti-spill, anti-splash apparatus. Only the expected results would be attained.

Claim 21 further requires that the outward angle comprise an approximately 30 degree angle tangential to at least one point from said outer mid section diameter to said outer lower section diameter. It would have been well within the purview of one of

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ordinary skill in the art to optimize the angle between the outer mid section diameter and the outer lower section diameter in order to maximize the stability of the anti-spill, anti-splash fluid holding apparatus. Only the expected results would be attained.

Claims 23 and 24 further requires that the outer mid section diameter and the outer lower section diameter be at a ratio of approximately 1 to 1.33. It would have been well within the purview of one of ordinary skill in the art to optimize the ratio between the outer mid section diameter and the outer lower section diameter in order to maximize the stability of the anti-splash, anti-spill fluid holding apparatus. Only the expected results would be attained.

Concerning claim 27, Thinnes discloses that the inner side surface, the outer side surface, said points along said inner side surface forming said inward angle, and said base comprises a single unitary article of fabrication as described above concerning claim 11. Thinnes does not appear to disclose the fluid holding volume or the angle between the inner mid section diameter to the inner upper section diameter. However, it would have been well within the purview of one of ordinary skill in the art to optimize fluid holding volume and the angle between the inner mid section diameter to the inner upper section diameter in order to maximize the efficiency and the appropriate amount of fluid needed for the usage of the fluid holding apparatus. Only the expected results would be attained.

9. Claims 2-6, 9, 10, 12-16, 21, 23-24, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slonim (U.S. Patent No. 6,116,426).

Claims 2-6 further requires that the inward angle comprising a no more than approximately 15 degree angle tangential to any point from said inner mid section diameter to said inner upper section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the angle tangential to any point from said inner mid section diameter to said inner upper section diameter to no more than 15 degrees in order to maximize the efficiency of the anti-splash, anti-spill in the apparatus. Only the expected results would be attained.

Claims 9 and 10 further requires that the inner section ratio be approximately 1 to 0.875 between said inner mid section diameter and said inner upper section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the ratio between the inner mid section diameter and the inner upper section diameter in order to maximize the efficiency of the anti-spill, anti-splash apparatus. Only the expected results would be attained.

Claims 12 and 13 further requires that the fluid holding volume is approximately 37.5 cubic centimeters. It would have been well within the purview of one of ordinary skill in the art to optimize the fluid holding volume in order to maximize the appropriate amount of fluid needed for the usage of the apparatus. Only the expected results would be attained.

Claims 14-16 further requires that the inner side surface height be approximately 3 centimeters and the inner mid section diameter by approximately 4 centimeters. It would have been well within the purview of one of ordinary skill in the art to optimize

inner surface height and inner mid section diameter in order to maximize the efficiency of the anti-spill, anti-splash apparatus. Only the expected results would be attained.

Claim 21 further requires that the outward angle comprises an approximately 30 degree angle tangential to at least one point from said outer mid section diameter to said outer lower section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the angle between the outer mid section diameter and the outer lower section diameter in order to maximize the stability of the anti-spill, anti-splash fluid holding apparatus. Only the expected results would be attained.

Claims 23 and 24 further requires that the outer mid section diameter and the outer lower section diameter be at a ratio of approximately 1 to 1.33. It would have been well within the purview of one of ordinary skill in the art to optimize the ratio between the outer mid section diameter and the outer lower section diameter in order to maximize the stability of the anti-splash, anti-spill fluid holding apparatus. Only the expected results would be attained.

Concerning claim 27, Slonim discloses that the inner side surface, the outer side surface, said points along said inner side surface forming said inward angle, and said base comprise a single unitary article of fabrication as described above concerning claim 11. Slonim does not appear to disclose the fluid holding volume or the angle between the inner mid section diameter to the inner upper section diameter. However, it would have been well within the purview of one of ordinary skill in the art to optimize fluid holding volume and the angle between the inner mid section diameter to the inner upper section diameter in order to maximize the efficiency and the appropriate amount

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of fluid needed for the usage of the fluid holding apparatus. Only the expected results would be attained.

Regarding claims 28 and 29, Slonim continues to disclose that the apparatus comprises a sterile state suitable for utilization in surgical procedures in combination with a surgical kit comprising:

Said fluid holding apparatus (14); and

At least one item of surgical equipment other than said fluid holding apparatus (numerals 4, 6, 8, 10, 12, 13, 16, 18, 20 22) as disclosed in column 3, lines 53-66.

10. Claims 25, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thinnes (U.S. Publication No. 2003/0189055) in view of Slonim (U.S. Patent No. 6,116,426).

Thinnes is relied upon as set forth above. Thinnes does not appear to disclose that the apparatus comprises a sterile state suitable for utilization in surgical procedures in combination with a surgical kit comprising:

The fluid holding apparatus; and

At least one item of surgical equipment other than said fluid holding apparatus.

However, such an anti-splash, anti-spill fluid holding apparatus is known to be used in a sterile state in conjunction with surgical kits. One such example is displayed by Slonim wherein the apparatus discloses:

An inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof, which is smaller than said inner mid section diameter;

An outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter;

An inward angle comprising a less than 90 degree angle tangential to any point along said inner side surface from said inner mid section diameter to said inner upper section diameter;

An open top circumscribed by said inner upper section diameter; and

A base circumscribed by said outer lower section diameter as shown in Figure 1 and referenced as numeral 14 (column 3, lines 53-66). More specifically, the apparatus is a conventional apparatus utilized to hold an antiseptic solution, which are generally hollow on the interior. Thus, the interior shape of the apparatus will coincide with the exterior shape of the apparatus which would provide an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter. With reference to the open top, it is known that the apparatus will have an open top in order to remove or add fluid to the apparatus, in which the inner upper section diameter will be circumscribed. Since the apparatus presents the dimensions as described above, then it is an anti-spill, anti-splash apparatus. The reference continues to disclose that the apparatus comprises a sterile state suitable for utilization in surgical procedures in combination with a surgical kit comprising:

Said fluid holding apparatus (14); and

At least one item of surgical equipment other than said fluid holding apparatus (numerals 4, 6, 8, 10, 12, 13, 16, 18, 20 22) as disclosed in column 3, lines 53-66.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the apparatus of Thinnies in a sterile state, as a part of a surgical kit, as such is a commonly known apparatus that is used with surgical kits as exemplified by Slonim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin C. Joyner whose telephone number is (571) 272-2709. The examiner can normally be reached on M-F 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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KCJ



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